DOCKET NO.: Polaroid 8522 (**BA-0331)
Application No.: 10/023,245
Office Action Dated: July 11, 2007

PATENT
REPLY FILED UNDER EXPEDITED
PROCEDURE PURSUANT TO
37 C.F.R. § 1.116

REMARKS

Claims 1 to 24 are pending in this application and are finally rejected. Applicants request reconsideration of the rejection in light of the following remarks.

Rejection under 35 U.S.C. § 103(a)

Claims 1 to 10, 13 to 18, and 21 to 24

Claims 1 to 10, 13 to 18, and 21 to 24 are finally rejected under 35 U.S.C. § 103(a) as allegedly obvious over U.S. Published Application No. 2002/0078160 ("Kemp application") in view of U.S. Published Application No. 2002/0113994 ("Smith application").

Applicants submit that it has not been established in the Office Action that the claimed invention is *prima facie* obvious. To establish a proper *prima facie* rejection, the following elements must be shown:

(1)   the reference(s) is (are) available as prior art against the claimed invention;

(2)   the motivation (explicit or implicit) provided by the reference(s), common sense, or common knowledge that would have rendered the claimed invention obvious to one of ordinary skill in the art at the time of the invention;

(3)   a reasonable expectation of success;

(4)   the basis for concluding that the claimed invention would have been obvious to do or obvious to try when there are only a finite number of identified, predictable solutions; and

(5)   the reference(s) teach(es) the claimed invention as a whole.

KSR International Co. v. Teleflex Inc., 127 S. Ct. 1727 (2007). Applicants submit that all of the above elements have not been established and, hence, a *prima facie* obviousness rejection is improper. The Kemp application does not disclose the two required separate and distinct data types and the Smith application does not provide the missing elements needed to reach

applicants' claimed invention. Thus, even if the two references were properly combinable, and applicants are not conceding the propriety of doing so, the combined disclosures would not achieve applicants' claimed method or system.

The method of claim 1 and its dependent claims and the system of claim 15 and its dependent claims involve two types of data:

1.   data necessary to ***provide the service*** being processed (for example, information to fulfill the service request such as an event ticket, coupon, image, or a compound document); and

2.   data required for the service (which is used to generate input data for the specific ***printer designated by the user*** to render the ***permanent record of the service***);

The first data type is handled at the service provider where the service is completed. The second data type is utilized by the service provider to provide a permanent record of the service (like a receipt), which is printed at a printer of the user's choosing.

Applicants submit that the Kemp application does not disclose, teach, or suggest the second data type that is a required limitation of all of the pending claims, *i.e.*, ***the specific printer is not designated by the user to render the permanent record of the service***. Rather, the Kemp application discloses a remote printing service where a user sends a file to the remote printing service provider over a data network, who in turn prints the file at its print shop for later pick-up by or delivery to the user. See paragraph **[0056]**. The Kemp application only describes user control with respect to the selection of the printer where the service (first data type) is provided, not where the permanent record of this service is printed (second data type). In fact, Kemp describes how a pop-up window appears to the user displaying certain information regarding the print job, and the user is requested to confirm the print request. This is a different method than what is claimed by applicants because the information provided by the user relates to the service (first data type) not to the designation of a printer to be used to render the permanent record of the service (second data type). Furthermore, Kemp makes no mention of a permanent record of this printing service that is transmitted to a remote printer and that is chosen by the user. The user responds to the pop-

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up window for the purpose of causing the service to be effected or cancelled, but does not do so to make a permanent record of the service, especially one that is printed at a printer designated by the user. Accordingly, the Kemp application does not anticipate the claimed invention and it further does not render it obvious because there is no teaching or suggestion for the user to control the designation of the printer to render the permanent record of the service.

The Office then turns to the Smith application to support its contention that it is well-known in the art and would have been an obvious modification of the Kemp system, to permit the user to control the selection of the specific remote printer. However, while the Smith application may disclose certain aspects claimed in the dependent claims, it fails to remedy the fundamental deficiency in the primary reference – *the missing data required for the service (which is used to generate input data for the specific printer designated by the user to render the permanent record of the service)* The Smith application only discloses a portable device that prints by transferring print information to a remote printer via the web. In the claimed method and system, the user operated communications device transmits two types of data – the first to request the required service from the remote service provider and the second to provide instructions to the service provider regarding where the permanent record of the transaction should be printed (two parties involved and two separate types of data). The Smith application only discloses one party (the user), who sends print information (one type of data) over the web to a remote printer; it does not contemplate a device that transmits data regarding where the user wants the permanent record of the transaction rendered to a service provider, who in turns carries out these requested instructions.

Applicants submit that it is impermissible for the Office to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. *In re Fritch*, 972 F.2d 1260, 23 USPQ.2d 1780 (Fed. Cir. 1992). The Office cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ.2d 1596, 1600 (Fed. Cir. 1988). The Kemp application itself is silent

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with respect to the printing of the second type of data, namely, printing of a permanent record of the transaction at a user designated remote printer. The Office has not pointed to any motivation in the reference itself or in combination with the Smith application that would teach or suggest printing of a permanent record of the transaction at a user designated remote printer. The only user interaction involves the initial selection of the service itself and whether the user wishes to proceed once the cost and properties are determined based on that selection. Nothing in the disclosures of Kemp or Smith – which both only show the user in control of the destination of the initial service – would suggest to have the user control the printing of a permanent record of the service. Applicants submit that the Office is engaging in the impermissible hindsight construction of the applicants' claimed invention and is not applying the correct test for obviousness.

In view of the foregoing arguments, applicants submit that the Office has failed to establish a proper *prima facie* obviousness rejection and, therefore, requests the Office to withdraw the rejection of claims 1 to 10, 13 to 18, and 21 to 24 under 35 U.S.C. § 103(a) over the Kemp application in view of the Smith application.

Claims 11, 12, 19, and 20

Claims 11, 12, 19, and 20 are finally rejected under 35 U.S.C. § 103(a) as allegedly obvious over the Kemp application in view of U.S. Published Application No. 2002/0100802 ("Sehr application") in further view of the Smith application. Applicants traverse the rejection because the Sehr application does not remedy the deficiency in the combination of the Kemp and Smith applications.

Claims 11 and 12 are dependent on claim 1 and recite the method wherein the requested service is an event ticket or coupon, respectively. Likewise, claims 19 and 20 are dependent of claim 15 and recite the system wherein the requested service is an event ticket or coupon, respectively.

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The Office relies on the Sehr application because it discloses providing an event ticket service or redeemable points in a card, accordingly to supply the event ticket or coupon missing from the Kemp application. However, the Sehr application is also silent with respect to the printing of the second type of data, namely, printing of a permanent record of the transaction at a user designated remote printer. Accordingly, the combination of the Sehr, Kemp, and Smith applications does not achieve applicants' claimed method or system.

In view of the foregoing arguments, applicants submit that the Office has failed to establish a proper *prima facie* obviousness rejection and, therefore, requests the Office to withdraw the rejection of claims 11, 12, 19, and 20 under 35 U.S.C. § 103(a) over the Kemp application in view of the Sehr application in further view of the Smith application.

Conclusions

Applicants request:

(1)   reconsideration and withdrawal of the rejection of the claims; and

(2)   allowance of claims 1 to 24.

In addition, applicants request an initialled copy of the PTO-1449 submitted with the latest supplemental Information Disclosure Statement. If the Examiner is of a contrary view, the Examiner is requested to contact the undersigned attorney at (404) 459-5642.

Date: October 8, 2007   /Wendy A. Choi/
                                                   Wendy A. Choi
                                                   Registration No. 36,697

WOODCOCK WASHBURN LLP
Cira Centre
2929 Arch Street, 12th Floor
Philadelphia, PA 19104-2891
Telephone: (215) 568-3100
Facsimile: (215) 568-3439